

TTAB

**UNITED STATES PATENT AND TRADEMARK  
OFFICE**

**Trademark Trial and Appeal Board**

2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: January 15, 2002

CINCOM SYSTEMS, INC.

2300 Montana Avenue  
Cincinnati, OH 452113899

Reg. No. 2016977  
Cancellation No. 92040138

Steve Petrov  
425 Wyandotte Street  
Bethlehem, PA 18015

*undeliverable*

Selections & Functions, Inc.

V.

CINCOM SYSTEMS, INC.

**Lalita Greene, Legal Assistant**

A petition, a copy of which is attached, has been filed to  
cancel the above-identified registration.

Proceedings will be conducted in accordance with the  
Trademark Rules of Practice.

**ANSWER IS DUE FORTY DAYS** after the mailing date hereof.  
(See Patent and Trademark Rule 1.7 for expiration date  
falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the  
Trademark Rules of Practice, set forth in Title 37, part 2,  
of the Code of Federal Regulations. The parties are  
reminded of the recent amendments to the Trademark Rules  
that became effective October 9, 1998. See Notice of Final  
Rulemaking published in the *Official Gazette* on September  
29, 1998 at 1214 TMOG 145. Slight corrections to the  
rules, resulting in a correction notice, were published in

the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

**Discovery and testimony periods are set as follows:**

Discovery period to open:	<b>February 4, 2002</b>
Discovery period to close:	<b>August 3, 2002</b>
30-day testimony period for party in position of plaintiff to close:	<b>November 1, 2002</b>
30-day testimony period for party in position of defendant to close:	<b>December 31, 2002</b>
15-day rebuttal testimony period for plaintiff to close:	<b>February 14, 2003</b>

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NOTE:** The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

TTAB

Registered on : November 19, 1996

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U.S. Patent &amp; TMO/c/TM Mail Rcpt Dt. #65

v.

Cincom, Inc.

BOX TTAB - FEE

**Assistant Commissioner for Trademarks**  
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Arlington, VA 22202-3513

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Selections & Functions, Inc., a corporation organized and existing under the laws of  
Massachusetts, with a business address of P.O. Box 505, Scituate, MA, 02066 believes that it has  
and will continue to be damaged by registration number 2016977 as it relates to miscellaneous  
services in Class 42 namely services related to computer software, and hereby petitions to cancel  
11/20/2001 SCORT1 00000124 2016977  
registration of the mark "TOTAL FRAMEWORK" for these goods and services.

**368.00 OP**

As grounds therefor, it is alleged that:

1. Registrant is an Ohio corporation known as Cincom Systems, Inc.
2. To the best of Petitioner's knowledge, the address of the current owner of the aforementioned registration is 2300 Montana Avenue, Cincinnati, OH 45211.
3. Petitioner, Selections & Functions, Inc. is the exclusive licensee of the "Framework" trademark of Borland International.
4. Petitioner and its predecessors in interest have adopted and continuously used the trademark "FRAMEWORK" for goods and services since at least 1984 in connection with the sale and licensing of object oriented computer software and related services which now fall under several classes including class 42.
5. Before Cincom filed its application for the aforementioned trademark it approached Selections & Functions with a request for a permit or license to use the trademark "Total Framework." Selections & Functions explained to Cincom in a detailed letter, through Selections & Functions lawyer William Strong, that the product is similar in description and geographic distribution and the concurrent use of tradenames would be likely to cause confusion in the marketplace.
6. In spite of the facts alleged in 5 above Cincom then proceeded to file an application to the Patent and Trademark Office. In that application Cincom declared that it did not know of any other products or services in the marketplace where a likelihood of confusion would exist.
7. Petitioner Selections & Function's product is an object oriented software product for use as an integrated business suite of applications including word processing, spread sheets,

graphics, database and idea processing, telecommunications and cross functional business applications development language and also user manuals sold together as a unit.

8. Petitioner also provides programming, data management, web hosting and other services in relationship to its product and its product's tradename.

9. The trademark "Framework" for Petitioner's product and service has been registered and used in interstate commerce since at least 1984 by Petitioner's predecessors Ashton-Tate and Borland International, Inc.

10. Petitioner currently owns the rights to the trademark in connection to the Framework product which it obtained from Borland International, Inc.

11. Registration number 1533028 was issued to Borland International, Inc. on April 4, 1989 under Class 16 (Paper Goods and Printed Matter) and has continuously been used to identify Petitioner's products and services in interstate and international commerce.

12. Registration number 1342190 was issued to Borland International under Class 9 based on an assignment from Borland's predecessor in interest Ashton-Tate Corporation and has continuously been used to identify Petitioner's products and services in interstate and international commerce.

13. From 1984 until its acquisition by Borland International, Ashton-Tate identified the earlier versions of what is now Petitioner's software product with the trademark "FRAMEWORK" and used this mark in interstate and international commerce.

14. There is no issue as to priority of use. Registrations for Petitioner's products and services issued long prior to the first date of use of Registrant, (Cincom, Inc.).

15. Petitioner has expended effort and expense in promoting its trademark "FRAMEWORK" and the goods and services sold under the mark (namely Framework,

Framework II, III, Framework IV, Framework V, Framework VI, Framework VII and Framework LX), with the result that the purchasing public, nationally and worldwide, has come to know, rely upon, and recognize the products and services by such mark. Petitioner has goodwill established in its mark.

16. If Registrant is permitted to retain the registration sought to be canceled, and thereby, the prima facie exclusive right to use in commerce of the mark "TOTAL FRAMEWORK" on the closely related goods and services sold and licensed by Petitioner, confusion in trade is likely to result from any concurrent use of Petitioner's mark and that of Registrant all to the great detriment of Petitioner.

17. Consumers of computer software and related services are likely to believe that the goods of Registrant sold under the mark "TOTAL FRAMEWORK" emanate from Petitioner and purchase or license such software instead of Petitioner's thereby resulting in loss of sales to Petitioner.

18. Continued concurrent use of the mark by Registrant and Petitioner may result in irreparable damage to Petitioner's reputation and goodwill, if the goods sold by Registrant or the services provided by Registrant are inferior, since purchasers and licensees are likely to attribute the source of Registrant's goods and services to Petitioner.

19. Continued concurrent use of the mark by Registrant and Petitioner will dilute Petitioner's trademark.

20. If Registrant is permitted to retain the registrations sought to be canceled, a cloud will be placed on Petitioner's title in and to its trademark "FRAMEWORK" and on its right to enjoy the free and exclusive use thereof in connection with the sale and licensing of its goods and services, all to the great injury of Petitioner.

21. Petitioner's predecessor in interest, Borland International, agrees that Petitioner is the rightful and lawful owner of the trademark Framework for the product and services described above.

22. Cincom applied for cancellation of the previously held by Ashton-Tate's and now Borland's "Framework" trademark in Great Britain. It is clear from this action that Cincom's intentions are to destroy Selections & Function's ability to sell Framework software worldwide and attempt to inherit the millions of Ashton-Tate's former customers by pretending to provide continuity to Ashton-Tate's and the Borland's products for independent developers' to which petitioner caters.

WHEREFORE, Petitioner deems that it will be damaged by registration number 2016977 and therefore petitions for cancellation thereof.

Selections and Functions, Inc.

By its Attorney,



Steve Petrov, Esq.  
425 Wyandotte Street  
Bethlehem, PA 18015  
(610) 691-6308

November 16, 2001

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail (Label No. ET700152725 VS) in an envelope addressed to: United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202 on November 16<sup>th</sup>, 2001.

  
Steve Petrov



## THE TRADEMARK TRIAL AND APPEAL BOARD WOULD LIKE YOU TO KNOW:

The TTAB Customer Service Center is available to

- \*answer telephone inquiries
- \*explain pertinent legal provisions and related administrative practices as they apply to specific cases
- \*provide status information on pending cases
- \*provide access to the files of pending cases
- \*resolve problems

The telephone number for the TTAB Customer Service Center is (703) 308-9300, extension 0 [zero].

The Patent and Trademark Office has two special boxes for expedited processing and distribution of documents filed with the TTAB. Envelopes and transmittal letters for TTAB should be addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202, followed by one of the following designations

"Box TTAB Fee": for papers filed with the TTAB that include filing fees, such as notices of opposition, petitions to cancel, and notices of ex parte appeal  
and

"Box TTAB": for all non-fee papers filed with the TTAB, such as requests for extensions of time to file notices of opposition and motions.

The TTAB Customer Service Center makes every effort to provide public access to application files, opposition files, cancellation files and concurrent use files immediately upon request for access. Files located will be made available in a central storage area accessible to the public.

Any questions, comments, or suggestions concerning TTAB service should be directed to Jean Brown, TTAB Technical Program Manager, at (703) 308-9300, extension 123 or Afendi Ziad, Supervisory Legal Assistant at (703) 308-9300, extension 205.

## NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)

The Trademark Trial and Appeal Board encourages you to consider alternative dispute resolution as a means of settling the issues raised in this opposition or cancellation proceeding. Although more than 95% of Board proceedings are decided prior to trial (by settlement or by entry of pre-trial judgment), alternative dispute resolution techniques might produce an earlier, mutually agreeable resolution of your dispute or might, at least, narrow the scope of discovery or the issues for trial. In either case, alternative dispute resolution might save you time and money.

Many non-profit organizations, both inside and outside the intellectual property field, offer alternative dispute resolution services. Listed below are the names and addresses of organizations that have indicated that they can make arrangements for alternative dispute resolution. The listings are given for your convenience; the Board does not sponsor nor endorse any particular organization's alternative dispute resolution services.

<b>International Trademark Association</b> Telephone: (212) 642-1726 Fax: (212) 768-7796 <a href="http://www.inta.org/adr/index.shtml">www.inta.org/adr/index.shtml</a> e-mail: <a href="mailto:lstigliano@inta.org">lstigliano@inta.org</a>	<b>CPR Institute for Dispute Resolution</b> Telephone: (212) 949-6490 Fax: (212) 949-8859 <a href="http://www.cpradr.org">www.cpradr.org</a> e-mail: <a href="mailto:info@cpradr.org">info@cpradr.org</a>
<b>American Intellectual Property Law Association (AIPLA)</b> 2001 Jefferson Davis Highway Suite 203 Arlington, Virginia 22202 Telephone: (703) 415-0780 Fax: (703) 415-0786	
<b>American Arbitration Association (AAA)</b> Headquarters 140 West 51 <sup>st</sup> Street New York, New York 10020-1203 Telephone: (212) 484-3266 Fax: (212) 307-4387	

Finally, if the parties consider using alternative dispute resolution in this proceeding, the Board would like to know; and if the parties actually engage in alternative dispute resolution, the Board would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and with what general result. Such a statement from the parties is not required but would be helpful to the Board in assessing the value of alternative dispute resolution in Trademark Trial and Appeal Board proceedings.

# PROCEEDING SYNOPSIS

United States Patent and Trademark Office - Trademark Trial and Appeal Board  
Trademark Opposition and Cancellation Proceedings Under 15 USC 1063, 1064; 37 CFR 2.101 et. seq.

## FILING OPPOSITION/CANCELLATION

- ❖ Any person (Opposer) may file a Notice of Opposition within 30 days against any mark published under 15 USC 1062(a) in Official Gazette; may oppose in whole or part.<sup>1</sup>
- ❖ Time for filing Notice may be extended by written request to TTAB. A first extension for not more than 30 days will be granted upon request. Further extensions may be granted for good cause. Extensions aggregating more than 120 days from pub. date not granted unless consented to by applicant or extraordinary circumstances. 37 CFR 2.102(c). Request should be in triplicate. 37 CFR 2.102(d).
- ❖ Any person (Petitioner) may file a Petition to cancel a registration in whole or in part, but only under conditions set forth in 15 USC 1064.<sup>2</sup> Geographic limitation will be considered by TTAB only in concurrent use proceeding. 37 CFR 2.99(h), 2.133(c).
- ❖ Opposer/Petitioner is in position of Plaintiff and Applicant/Respondent is Defendant. 37 CFR 2.116(b).
- ❖ Notice/Petition corresponds to complaint in civil action. 37 CFR 2.116(c).
- ❖ Amendment to pleadings in accord with Rule 15, Fed. Rules of Civil Procedure (FRCP). 37 CFR 2.107, 2.115.

## MAILING PROCEDURES

- ❖ Certificate of Mailing or Transmission and Express Mail procedures effective for all papers. 37 CFR 1.8, 1.10.

## INSTITUTION OF PROCEEDING; WITHDRAWAL

- ❖ TTAB examines Notice/Petition for formal requirements and sends notification to Defendant, generally within few weeks of filing date. Duplicate copy of Notice/Petition and Exhibits sent to Defendant. 37 CFR 2.105, 2.113.
- ❖ Notice/Petition may be withdrawn without prejudice before Defendant files Answer. 37 CFR 2.106(c), 2.114(c). With written consent of Defendant, later withdrawal may be without prejudice.
- ❖ Defendant may not abandon application or surrender registration without prejudice except with written consent of Plaintiff. 37 CFR 2.135, 2.134.

## ANSWER; MOTIONS

- ❖ Time for Answer set by TTAB for 40 days from Notification mailing date.<sup>3</sup> Counterclaim should be filed with answer or promptly upon discovery of information supporting Counterclaim. 37 CFR 2.106(b), 2.114(b).

- ❖ Time for reply to Counterclaim set by TTAB for not less than 30 days from TTAB action mailing date. 37 CFR 2.106(b), 2.114(b).
- ❖ Motions may be brought before TTAB in writing and with Brief in support. Brief in opposition thereto, 15 days (30 days for summary judgment motion). Briefs limited to 25 pages. Reply Brief, if filed, 15 days, limited to 10 pages. Reconsideration 30 days after decision; Opposition Brief, 15 days. 37 CFR 2.127. Most motions used in Federal practice are applicable.

- ❖ Motions for Summary Judgment, to Compel, and to Test Sufficiency of Responses to Requests for Admissions, if filed, due before Plaintiff testimony period opens. 37 CFR 2.127(e), 2.120(e), 2.120(h).

## TRIAL DATES

- ❖ TTAB issues Order setting opening and close of Discovery and Trial dates. Discovery set for period of 180 days; 30-day Pl. Testimony period closes 90 days after close of Discovery period; 30-day Def. Test. period closes 60 days after Pl. Test. period; 15-day Pl. Rebuttal Test. period closes 45 days after Def. Test. period. 37 CFR 2.120(a), 2.121.

- ❖ In cases where Counterclaim filed, TTAB sets additional time periods for testimony and briefing.

## DISCOVERY PERIOD

- ❖ Interrogatories, Reqs. for Prod. Of Docs. & Things, and Reqs. for Adm., if served, must be served by last day of Discovery period. Written Responses within 30 days from date of service of Disc. Reqs. FRCP apply except as otherwise provided. 37 CFR 2.116, 2.120(a). Extension of Time to respond to discovery granted upon cause or by stipulation.<sup>4</sup>

- ❖ Interrogatories limited to proceeding total of 75, counting subparts; additional interrogatories allowed upon motion for good cause or by stipulation. 37 CFR 2.120(d)(1).

- ❖ Discovery Depositions (noticed and taken within Disc. Period) in District where deponent resides or is employed. 37 CFR 2.120(a), 2.120(b). Either party may request designation of witnesses under FRCP 30(b)(6), 31(a).

## PLAINTIFF'S TRIAL PERIOD

- ❖ Plaintiff's Testimony-In-Chief. Opens 60 days after Discovery Period closes, and runs for 30 days (refer to Order).

- ❖ Testimony taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Plaintiff serves Transcript of testimony and copies of documentary exhibits on adverse party within 30 days after completion of taking testimony. Certified transcript and exhibits filed with TTAB. 37 CFR 2.125.
- ❖ Notice of Reliance as appropriate on Discovery Deps., Adms. and Int. Answers, with copies of same, due before close of Test. 37 CFR 2.120.<sup>5</sup>
- ❖ Involved app. or reg. files are in evidence for relevant and competent purposes. Publications in gen. Circ. or in libraries, and official records, may be received if appropriate Notice of Reliance is filed and copies submitted within Test. period. 37 CFR 2.122.

- ❖ Motion under 37 CFR 2.132, if filed, due after close of Pl.'s Test. period & before opening of Def.'s.

## DEFENDANT'S TRIAL PERIOD

- ❖ Opens 30 days after close of Pl.'s Test. period. Runs for 30 days.
- ❖ Test. taken by deposition upon oral examination or upon written questions. 37 CFR 2.123, 2.124.
- ❖ Notice of Reliance on Discovery responses also due within Test. period, if filed. 37 CFR 2.120.

- ❖ Notice of Reliance on gen. circ. publ. and official records due within Test. period, if filed. 37 CFR 2.122.

- ❖ Def. serves Test. transcript on Pl. within 30 days and files certified transcript and exhibits with TTAB. 37 CFR 2.125.

## PLAINTIFF'S REBUTTAL PERIOD

- ❖ Rebuttal Test. period for Pl. opens 30 days after close of Def.'s Test. period and runs for 15 days.
- ❖ Pl. may file Notice of Reliance under 37 CFR 2.120, 2.122, with matter relied on, and take Test. to rebut Def. Test. and other evidence.

- ❖ Pl. serves and files Transcript of Rebuttal Test. and exhibits in accordance with 37 CFR 2.125.

## BRIEFS; ORAL HEARING

- ❖ Pl. Brief due 60 days after Rebuttal period closing.<sup>6</sup>
- ❖ Def. Brief, if filed, due 30 days after Pl. Brief due.
- ❖ Pl. Reply Brief, if filed, due 15 days after Def. Brief due. 37 CFR 2.128.